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Office Action dated 08/11/2005

REMARKS

Claims 50-57 are added. Claims 1-22, 24-41, and 44-57 are pending in the present application.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 3), which states that **TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM.** The **identical invention** must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236. 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). **The elements must be arranged as required by the claim.** *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Referring to the 102 rejection of claim 1, the system comprises a *communication station configured to receive a return link wireless signal* and a *housing* remotely located with respect to the communication station. The Office on page 2 of the Action identifies references 203 of Fig. 2 and 307 of Fig. 3 as teaching the claimed communication station. On page 3 of the Action, the Office identifies references 310, 310a, 312, 300 as allegedly teaching the claimed housing. Initially, reference 310 is disclosed as a band pass filter, reference 310a is a limiting amplifier, reference 312 is a demodulator and 300 is a processor. The circuits 310, 310a, 312, 300 fail to disclose a *housing* a specifically claimed. The Office has provided no explanation as to how the circuits are to be considered to disclose or suggest the specifically claimed housing. The housing is not disclosed nor suggested by the prior art and claim 1 is allowable for at least this reason in accordance with the above authority.

In addition, it is clear from Fig. 3 that circuits 307, 310, 310a, 312 and 300 all reside within a single interrogator 103. The Office fails to provide any explanation as to

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how the circuit components which reside within the same device are to be considered to be remotely located with respect to each other. The claimed housing remotely located with respect to the communication station is not disclosed nor suggested by the prior art and claim 1 is allowable for at least this reason. Applicants respectfully request allowance of claim 1 in the next Action.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, dependent claim 4 recites the adjustment circuitry is configured to output the return link communication signal at a substantially constant level. The Office at page 3 of the Action baldly identifies "BPF" and "limiting amp" without identification of any particular teachings of the prior art as allegedly teaching limitations of claim 4. Band pass filtering and a limiting amplifier fail to disclose or suggest the limitations of claim 4 including output of the signal at a substantially constant level as claimed. Limitations of claim 4 are not disclosed by the prior art and the Office has failed to establish a proper 102 rejection. In the event that a rejection of claim 4 is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by*

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Applicants, the particular teachings relied upon must be designated as nearly as practicable. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 4 is not found to be allowable.

Referring to dependent claims 5-6, Lee has not been demonstrated to be prior art. The present application claims priority to March 1999 and Lee was filed in December 2000. Applicants respectfully request withdrawal of the rejections over Lee.

Referring to dependent claim 7, the communication circuitry includes a coaxial RF cable. The Office on page 3 of the Action relies upon the teachings of reference 308 "and amplifier" as allegedly disclosing the claimed limitations. Applicants respectfully submit that reference 308 is a quad mixer which is void of any coaxial teachings. The Office further states in support of the rejection that a cable connected from mixer to amplifier is a cable. Applicants respectfully disagree. Initially, reference 308 and the downstream amplifier are within the same device 103. It is nonsensical to use a cable within the same device to interconnect circuits of the same device. Applicants have electronically searched MacLellan and failed to uncover any teachings that the connection between the mixer and amplifier or any other connection of Fig. 3 is a cable. Further, Applicants have electronically searched MacLellan and failed to uncover any mention of a cable *let alone the specifically claimed coaxial cable*. Positively recited limitations of claim 7 are not disclosed by the prior art and the anticipation rejection of claim 7 is improper for at least this reason.

Referring to dependent claim 8, the system comprises communication circuitry including *plural wireless transceivers individually coupled with one of the housing and the communication circuitry*. On page 9 of the Action, the Office states that MacLellan

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fails to disclose limitations of claim 8 and relies upon teachings of Reis. Applicants respectfully submit that the Office has failed to present a *prima facie* 103 rejection of claim 8 and the claim is allowable.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 3).

MPEP 2142 (8th ed., rev. 3) states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the *examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness*. The *examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness*, that is, the initial burden is on the *examiner to provide some suggestion of the desirability of doing what the inventor has done*. MPEP §2142 (8th ed., rev. 3).

Applicants respectfully submit the motivational rationale is insufficient in view of precedent set forth by the Federal Circuit, and accordingly, the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be *thorough and searching*. It must be based *on objective evidence of record*. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some *objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art* would lead that individual to combine the relevant

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teachings of the references. The Lee Court stated that the Examiner's conclusory statements in the Lee case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and *can not be resolved on subjective belief and unknown authority*. The Court also stated that *deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense but rather specific 'actual findings' are needed*. The Court further stated that the determination of patentability must be based on evidence. MPEP 2143.01 (8th ed., rev. 3) cites *In re Lee* and states the importance of relying upon objective evidence and making specific factual findings with respect to the motivation to combine references.

With respect to page 9 of the Action, it is alleged that the combination is appropriate in order to be able to broadcast commands on a one-to-many basis or even one to one basis on multiple transmitters and to receive responses from the abundant remote tags on multiple receivers. Applicants respectfully submit that the rationale provided by the Office is insufficient.

Initially, the Office has stated that references 203, 307 of MacLellan allegedly disclose the claimed communication station and that references 310, 310a, 312, 300 allegedly disclose the claimed housing. In accordance with the constructions and combination of reference teachings provided by the Office, wireless communication circuitry is provided between circuit components 307 and 310, 310a 312 and 300 of the single interrogator unit 103 of MacLellan. Applicants respectfully submit there is no motivation to increase the complexity of the device 103 to include internal wireless communications for no benefit. The Office has failed to establish a proper 103 rejection for this reason alone.

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Further, as disclosed in Fig. 1 of MacLellan, communications of interrogator 103 are already provided with plural remote tags 105, 106, 107. The Office has failed to identify any benefit to the system of MacLellan to compel one to combine the references as combined by the Office in support of the 103 rejection. Applicants respectfully submit that the combination is not supported by the objective evidence of record inasmuch as the complexity of the interrogator 103 of MacLellan would increase dramatically to include the wireless communications with absolutely no benefit to the system of MacLellan already communicating with remote tags or motivate one to combine the reference teachings of Reis. Furthermore, the mere fact that references can be combined does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination.* MPEP §2143.01III (8th ed., rev. 3) citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is no motivation to combine the reference teachings and the Office has failed to establish a proper 103 rejection for at least this reason.

Furthermore, the combination of teachings fails to disclose limitations of claim 8 even if the teachings are combined. More specifically, the teachings of col. 9, lines 35-65 relied upon by the Office refer to communications of the RF modules with respect to tags and fails or suggest the *wireless transceivers of the communication circuitry* of claim 8 which is in addition to the claimed communication station configured to output and receive forward and return link wireless signals as claimed. In sum, claim 8 recites two components (the communication station and communication circuitry) each capable of wireless communications. The combined teachings of the art merely teach wireless communications between the interrogator and tags. Limitations of claim 8 are not

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disclosed nor suggested by the prior art taken alone or in combination and claim 8 is allowable for at least this reason.

Referring to independent claim 10, Applicants respectfully submit that the Office has failed to establish a prima facie 103 rejection and claim 10 is allowable for at least this reason. Initially, as set forth above, there is no motivation to combine the reference teachings. For example, there are no improvements resulting from the combination and the combination greatly increases the complexity of the system with no benefits resulting therefrom. MacLellan already discloses interrogator communications with plural tags. There is no reason to look to Reis for additional teachings when MacLellan discloses the teachings for which Reis is presented. In sum, there have been no deficiencies of the primary reference identified by the Office to motivate one to look to another reference for meaningful corrective teachings. There is no evidence of record that the primary reference being modified suffers from any deficiencies or that any deficiencies would be solved by the combination proposed by the Office. There is no evidence of record that any improved operations of the primary reference would result from the combination proposed by the Office. The only motivational rationale provided by the Office is unsupported and conclusory and/or improperly based upon Applicants' own teachings. The Office has failed to establish proper motivation for at least the above-mentioned compelling reasons and Applicants request withdrawal of the 103 rejection in the next Action.

Furthermore, even if the references are combined, the combination fails to disclose or suggest limitations of claim 10. For example, circuits 310, 310a, 312, 300 of MacLellan may not be fairly interpreted to disclose a housing, let alone a housing remotely located with respect to the communication stations as claimed. These limitations are not disclosed by the prior art and the rejection is improper for this additional reason.

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The claims which depend from independent claim 10 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 18, the Office relies upon the same motivational rationale as the rejections of the previously discussed claims. Applicants respectfully submit that the motivation is insufficient for the reasons set forth above and the Office has failed to establish a proper *prima facie* 103 rejection for at least this reason.

Furthermore, even if the references are combined, the combination fails to disclose or suggest limitations of claim 18 inasmuch as circuits 310, 310a, 312, 300 of MacLellan may not be fairly interpreted to disclose a housing, let alone a housing remotely located with respect to at least one of the communication stations as claimed. These limitations are not disclosed and the rejection of claim 18 is improper for this additional reason.

The claims which depend from independent claim 18 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to dependent claim 22, the communication stations are defined to be individually positioned to receive return link wireless signals within one of a plurality of communication ranges. The Office at page 15 of the Action relies upon col. 9, lines 35-65 of Reis as allegedly teaching such limitations. Applicants have failed to locate any mention of plural communication ranges or positioning of communication stations relative thereto in the teachings relied upon by the Office. Positively recited

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Limitations of claim 22 are not disclosed nor suggested by the prior art even if the prior art references are combined and claim 22 is allowable for at least this reason.

Referring to independent claim 24, the method recites *receiving a return link communication signal within a housing of the interrogator remotely located from the communication station*. The Office relies upon teachings of circuits 310, 310a, 312, 300 as disclosing the claimed receiving within the housing of the interrogator. Applicants respectfully submit that the circuits 310, 310a, 312, 300 fail to teach a housing or receiving within a housing as claimed. Claim 24 is allowable for at least this reason. Further, circuits 310, 310a, 312, 300 are resident within the same interrogator 103 which includes circuit 307 identified as allegedly teaching the claimed communication station, and accordingly circuits 310, 310a, 312, 300 fail to teach or suggest the claimed receiving within the *housing remotely located from the communication station* as claimed. Numerous limitations of claim 24 are not disclosed nor suggested by the prior art of record and claim 24 is allowable for at least this reason.

The claims which depend from independent claim 24 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 31, there is no motivation to combine the reference teachings of Reis with MacLellan and the Office has failed to establish a proper *prima facie* 103 rejection for at least this reason. More specifically, at pages 15-16 of the Action, the Office identifies teachings of the prior art which allegedly correspond to limitations of the claims with no motivation to combine the references.

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The Office has failed to meet their burden of establishing proper motivation and the 103 rejection is improper.

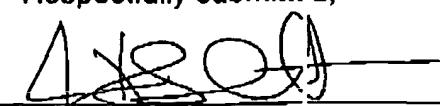
Furthermore, the method recites *providing the interrogator having a housing and a plurality of communication stations remotely located from the housing*. Circuits 310, 310a, 312, 300 of MacLellan relied upon by the Office fail to disclose a housing. Furthermore, the Office relies upon reference 307 as allegedly disclosing a communication station. Circuits 310, 310a, 312, 300 resident within the same device as circuit 307 fails to disclose or suggest the housing remotely located from the communication stations. Accordingly, even if the references are combined, limitations of claim 31 are not disclosed by the prior art and the obviousness rejection of claim 31 is improper for at least this additional reason.

The claims which depend from independent claim 31 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants hereby add new claims 50-57 which are supported by Figs. 1 and 7-10 and the associated specification teachings of the originally filed application.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Dated: 5/30/06

Respectfully submitted,
By: 
James D. Shaurette
Reg. No. 39,833